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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,327	11/13/2003	Daniel Craven	P-US-PR-1091	1986
7590	03/22/2006			EXAMINER
Michael P. Leary Group Patent Counsel Black & Decker Corporation, Mail Stop TW199 701 E. Joppa Rd Towson, MD 21286			DURAND, PAUL R	
			ART UNIT	PAPER NUMBER
			3721	
DATE MAILED: 03/22/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/712,327	CRAVEN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Paul Durand	3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 15 February 2006.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1 and 4-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1,4-8,10,11,13,15-17 is/are rejected.

7)  Claim(s) 9,12 and 14 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 13 June 2005 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02/06

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_ .

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/15/2006 has been entered.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,4,5,13,15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Bausch (US 4,588,910).

In claim 1, Bausch discloses the invention as claimed including a tool housing with an electric motor "M", integrated switch unit comprised of motor control unit, which turns the motor on and off (indicated by on/off housing 35), a first manual switch member in the form of trigger 2, adjacent to the switch unit and operatively connected to the motor control unit, a second manually operated switch member 9, connected to the motor control unit via actuator (not shown), which drives the motor in a forward and

reverse direction, the second switch remotely located from the switching unit and depending on the tool orientation and as shown in figure 3, located on an upward facing surface of the tool housing which can be seen during normal operation of the tool and linkage assembly in the form of crank 25, which operatively connects the second switch to the motor control unit through an actuator in the form of pin 40, which is moved in response to the movement of the second switch member to move the motor in a forward or reverse direction (see Fig. 1-3,6 and C3,L4 – C4,L59).

In claim 4, Bausch discloses the invention as claimed including the first manual switch member located on a downward portion of the tool.

In claim 5, Bausch discloses the invention as claimed including linkage 25 pivotally mounted at 40 (see Figs. 3 and 6).

In claim 13, Bausch discloses the invention as claimed including first arm 27, connecting the second switch 9 to the linkage 25 (see Fig. 3).

In claim 15, Bausch discloses the invention as claimed including power member in the form of trigger switch 2 (see Fig.2).

In claim 16, Bausch discloses the invention as claimed including the first switch member and switch unit 35, arranged such that when the first switch member is acted on by a user of the tool so as to power a motor, it holds the actuator (not shown) against movement by the linkage 25 by engaging the linkage at 29 (see Fig. 3,7 and C4,L11-28).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bausch.

In claims 6,7 and 10, Bausch discloses the invention as claimed including the linkage having an annular portion 30, which engages a boss 40 on the switch housing. What Bausch does not disclose is the linkage rotating on a boss located on the motor housing. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have located the linkage on the motor housing next to the motor, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

In claim 8, Bausch discloses the invention as claimed including a closed end of the motor housing located at the rear end (see fig.2).

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bausch in view of Schell et al (US 5,738,177).

Bausch discloses the invention substantially as claimed except for the housing being formed as a jam pot housing. However, Schell teaches that it is old and well known in the art to provide a housing formed from a jam pot design for the purpose of increasing the ease of manufacture (see Fig.1 and C5,L29-44). Therefore, it would

have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Bausch with the housing as taught by Schell for the purpose of increasing the ease of manufacture.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bausch in view of Dibbern (US 4,684,774).

In claim 17, Bausch discloses the invention as claimed including a hand held tool with housing, upper and lower facing portions, downward extending handle, electric motor "M", integrated switch unit, with motor control unit, which turns the motor on and off (indicated by on/off housing 35) and located in the handle area, first manual switch member in the form of trigger 2, operatively connected to the motor control unit and projecting through the handle, second manually operated switch member 9, located remotely (not integral with the switch unit) in a position that allows the user to see the switch during normal operation by it's projected location on the handle, linkage assembly in the form of crank 25, which operatively connects the second switch to the motor control unit through an actuator in the form of pin 40, which is moved in response to the movement of the second switch member to move the motor in a forward or reverse direction (see Fig. 1-3,6 and C3,L4 – C4,L59). What Bausch does not disclose is the position of the switch projecting from the top of the housing and the switch seated on a boss. However, Dibbern teaches that it is old and well known in the art to provide an adjusting member 62, with a switch member 79, projecting from the top of the tool, which rotates longitudinally to a tool motor, mounted on a bearing boss 21 and fixing boss 23 which attaches rear cover and limits the movement of the adjusting member 62

for the purpose of operating and reducing the size of a tool (see Figs. 2,11,13 and C5,L21-37).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Bausch with the switch arrangement as taught by Dibbern for the purpose of operating and reducing the size of a tool.

#### ***Allowable Subject Matter***

8. Claims 9,12 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

9. The examiner agrees with applicant's arguments in respect to claims 9,12 and 14, the previous ground of rejection has been removed and the claims now stand objected.

In claim 1, applicant argues that the claims as amended are distinguished over the prior art of Bausch. The examiner does not agree. As noted above, depending on the manner and orientation the tool is operated and as shown in figure 3, the second switch 9, can be located on an upper portion of the tool. Furthermore, Bausch incorporates two integrally connected switch units 35 and 36 which incorporate the first

and second switches. Switch 36 is the reversing switch controlled by member 9 and switch 35 is the on/off switch controlled by member 2.

Furthermore, the recitation that the "switch can be seen by a user ...", is an intended use recitation, which does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitation. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In claim 4, applicants' arguments regarding the combination of Bausch and Becker are moot in view of the rejection solely based on Bausch.

This action is non-final.

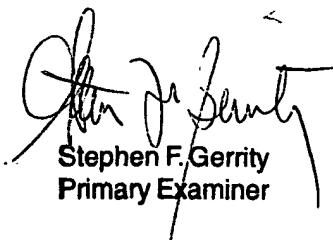
### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 571-272-4459. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand  
March 17, 2006



Stephen F. Gerrity  
Primary Examiner